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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,280	11/19/2001	Akihiko Katou	Q67359	8375

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EXAMINER
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ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/988,280

**Applicant(s)**

KATOU, AKIHIKO

**Examiner**

Nicholas D. Rosen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/25/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-20 have been examined.

#### ***Claim Objections***

Claims 3, 4, and 5 are objected to because of the following informalities: Each of claims 3, 4, and 5 recites, "in a case where to specify the positional information". This is unidiomatic and ungrammatical. Appropriate correction is required.

Claim 4 is objected to because of the following informalities: In the third line of claim 4, "to be received" should be "received," and (in the fourth and fifth lines) "to said mobile-telephone terminal" should be "at [or: by] said mobile-telephone terminal."

Appropriate correction is required.

Claim 5 is objected to because of the following informalities: In the fifth line of claim 5, "to be received" should be "received," and (in the fifth and sixth lines) "to said mobile-telephone terminal" should be "at [or: by] said mobile-telephone terminal."

Appropriate correction is required.

Claim 7 is objected to because of the following informalities: Claim 7 recites, "in a case where to acquire the stock information". This is unidiomatic and ungrammatical. Appropriate correction is required.

Claim 8 is objected to because of the following informalities: Claim 8 recites, "said store terminal," which lacks antecedent basis. (Perhaps claim 8 was intended to depend on claim 7 rather than claim 1.) Appropriate correction is required.

Claim 11 is objected to because of the following informalities: In the third line of claim 11, "to be received" should be "received," and (in the fourth and fifth lines) "to said mobile-telephone terminal" should be "at [or: by] said mobile-telephone terminal."

Appropriate correction is required.

Claims 15 and 16 are objected to because of the following informalities: In the third line of claim 15, "to be received" should be "received," and (in the fourth and fifth lines) "to said mobile-telephone terminal" should be "at [or: by] said mobile-telephone terminal." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 20 recites a computer program per se, which is not a process, machine, manufacture, or composition of matter, and therefore cannot be patented. Examiner suggests claiming a program in the format, "A computer-readable medium containing computer-implementable instructions, which, when read, cause a computer to carry out a method comprising . . ." (Complications might arise in the instant case, because several computers would apparently be involved in carrying out the procedures of claim 20. A recitation of the program or programs should be written accordingly.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-9**

Claims 1, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano (U.S. Patent 6,317,718) in view of Nguyen (U.S. Patent 5,797,089), Lo et al. (U.S. Patent 6,523,040), and official notice. As per claim 1, Fano discloses a method of providing a mobile terminal with store information, the method comprising: receiving commodity information regarding a commodity selected by the user (column 47, line 41, through column 48, line 44; Figure 27); and searching a store-information database storing the commodity information and store summary information including a name of one or more stores dealing the commodity specified in the commodity information, based on the commodity information and positional information representing a position of the mobile terminal, and determining one store located closest to the position of the mobile terminal among any other stores dealing the specified commodity (column 47, lines 20-65). Insofar as Fano is not explicit about searching a store-information database, this is held to be inherent from the information provided. Fano further discloses preparing a list of the specific items available and their prices at a store determined to be closest (column 47, lines 49-55), implying accessing stock information representing a stock of commodities dealt by the determined store; and sending the

store summary information regarding the determined store which is located closest to the position of the mobile terminal and the acquired stock information to the mobile terminal, and having the mobile terminal display the sent information (column 47, lines 20-65). Fano does not disclose that his mobile terminal is a mobile-telephone terminal (Fano discloses using a personal digital assistant [PDA]), but it is well known to combine the functions of a PDA and a mobile telephone, as taught by Nguyen (Abstract; Figure 4; column 2, line 65, through column 3, line 15; column 5, lines 47-67; column 6, lines 35-44). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the mobile terminal to be a mobile-telephone terminal, for the obvious advantage of enabling the user to make telephone calls as desired.

Fano does not expressly disclose setting at least one mobile terminal to display a commodity selection menu, on which a user selects a commodity from a plurality of commodities, but Lo teaches using mobile terminals to search products items from an electronic catalog, inter alia (column 1, lines 32-35), implying that such a menu is displayed. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to set at least one mobile terminal to display a commodity selection menu, on which a user selects a commodity from a plurality of commodities, for the obvious advantage of enabling users to easily select desired commodities to be located in nearby stores.

Fano does not expressly disclose that the store summary information includes an address and a phone of one or more stores as well as the store name, but official notice

is taken that it is well known to maintain addresses and phone numbers in databases together with names (e.g., a telephone directory). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the store summary information to include an address and a phone of one or more stores, for the obvious advantage of enabling a user to easily go to or call a store.

As per claim 6, Fano discloses that the positional information is obtained by said mobile terminal performing data communication with a GPS (Global Positioning System) satellite (Abstract; column 2, lines 26-54; column 47, lines 20-40).

As per claim 9, Fano discloses giving an order from a mobile terminal for the selected commodity, which implies displaying a commodity ordering page; receiving said commodity-ordering information; and sending the received commodity-ordering information to a store terminal managing the stock information (Figure 9; column 27, lines 11-67). Fano does not disclose sending advance-ordering information representing an advance order for the ordered commodity to the mobile terminal in response to a reply for the commodity-ordering information from the store terminal, but official notice is taken that it is well known to send confirmation of orders. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to send the advance-ordering information as recited, for the obvious advantages of assuring the user that his order had been received and would be made available, and documenting the agreement to the order should any dispute arise.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano, Nguyen, Lo, and official notice as applied to claim 1 above, and further in view of

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Stacklin ("Allen Telecom Hopes Wireless 911 Rings up Business"). As per claim 2, Fano does not disclose that the positional information is obtained by a mobile telephone base station to which said mobile terminal is connected, but Stacklin teaches obtaining positional information by a mobile telephone base station to which a mobile phone is connected (paragraph beginning "One technology is"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to obtain the positional information by a mobile telephone base station to which said mobile terminal is connected, for the obvious advantage of obtaining positional information for mobile phones not equipped with GPS.

As per claim 3, in Stacklin the mobile telephone base stations would have to be identified to enable the computer to triangulate as disclosed.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano, Nguyen, Lo, and official notice as applied to claim 1 above, and further in view of MacDonald (U.S. Patent 5,732,354). As per claim 4, Fano does not disclose receiving intensity information of waves received from one or more mobile-telephone base stations at said mobile terminal and base-station identification information of the one or more neighboring mobile-telephone base stations; and based on the intensity and base-station identification information, specifying the positional information, but this is well known, as taught by MacDonald (Abstract; column 1, line 64, through column 2, line 37; line 3, lines 25-49). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to specify the positional



information by these means, for the obvious advantage of determining the positions of mobile telephones or similar devices not equipped with GPS.

As per claim 5, claim 5 is similar to claim 4. MacDonald does not teach accessing a position-information server, and providing the positional information, but servers are well known (as disclosed by Fano extensively, e.g., column 34, lines 15-23). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use a server, for such obvious advantages as calculating a mobile terminal's position or making that position available for use in locating a nearby store.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano, Nguyen, Lo, and official notice as applied to claim 1 above, and further in view of Hanzek (U.S. Patent 6,654,726). As per claim 7, Fano does not expressly disclose accessing a store terminal managing the stock information (although this might be considered implicit from the system's ability to prepare a list of the specific items available and their prices [column 47, lines 49-53]), but Hanzek teaches accessing store computers with databases of stock information (Figures 7A and 7B; column 11, lines 10-45). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to access a store terminal managing the stock information, for the obvious advantage of being able to prepare a list of the specific items available at at least one store and their prices.

As per claim 8, Hanzek discloses that an inventory database (which includes inventory data from multiple store computers) may be updated in real-time (column 11,

lines 41-43), but does not expressly disclose that this is done by the store terminal(s). However, official notice is taken that it is well known for store terminals to update stock information in real time (e.g., when items are scanned at a checkout counter). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the stock information to be updated in real time by the store terminals, for the stated advantage of making the most recent data available for searching.

#### **Claims 10-11**

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fano (U.S. Patent 6,317,718) in view of Nguyen (U.S. Patent 5,797,089), Lo et al. (U.S. Patent 6,523,040), and official notice. Claim 10 is largely parallel to claim 1, and rejected on essentially the same grounds. Claim 10 recites sending commodity information rather than receiving it, but sending and receiving information are two sides of the same coin.

Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fano, Nguyen, Lo, and official notice as applied to claim 10 above, and further in view of MacDonald (U.S. Patent 5,732,354). Claim 11 is largely parallel to claim 4, and rejected on essentially the same grounds.

#### **Claims 12-19**

Claims 12, 17, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano (U.S. Patent 6,317,718) in view of Nguyen (U.S. Patent

5,797,089), Lo et al. (U.S. Patent 6,523,040), and official notice. Claim 12 is largely parallel to claim 1, and rejected on essentially the same grounds. Fano additionally discloses servers (extensively, e.g., column 27, lines 11-67; column 34, lines 15-23).

Official notice is taken that servers, being computers, are well known to commonly have such features as processors, storage units, input/output units, performing data communications, communication units, and databases. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the server to have these features, to enable it to carry out its disclosed functions.

Claim 17 is largely parallel to claim 6, and rejected on essentially the same grounds.

Claim 18 is largely parallel to claim 9, and rejected on essentially the same grounds. Additionally, claim 18 recites the store terminal managing the stock information of commodities dealt by the nearest store, which is not disclosed by Fano in column 27, but Fano does disclose suggesting the closest store in column 47, lines 49-57.

As per claim 19, Fano does not disclose that said store-information database is connected to the communications network through the network, but official notice is taken that it is well known for databases to be available through communication units and networks (e.g., the Internet, or a WAN or LAN). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the store-information database to be connected to the communication unit

through the network, for the obvious advantage of accessing a database that could be elsewhere for reasons of security, redundancy of data, data held by stores or data suppliers distinct from the operators of the server, etc.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano, Nguyen, Lo, and official notice as applied to claim 12 above, and further in view of Stacklin ("Allen Telecom Hopes Wireless 911 Rings up Business"). Claims 13 and 14 are largely parallel to claims 13 and 14, respectively, and rejected on essentially the same grounds.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano, Nguyen, Lo, and official notice as applied to claim 12 above, and further in view of MacDonald (U.S. Patent 5,732,354). Claims 15 and 16 are largely parallel to claims 4 and 5, respectively, and rejected on essentially the same grounds.

#### **Claim 20**

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fano (U.S. Patent 6,317,718) in view of Nguyen (U.S. Patent 5,797,089), Lo et al. (U.S. Patent 6,523,040), and official notice. Claim 20 is parallel to claim 1, and rejected on essentially the same grounds. Fano discloses a computer program or programs to carry out his invention (e.g., column 3, line 65, through column 10, line 67; column 14, lines 34-54; column 17, line 53, through column 18, line 22; Figures 3, 4, and 5; note also claims 10-17).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sugiyama et al. (U.S. Patent 6,339,746) disclose a route guidance system and method for a pedestrian. Pentel (U.S. Patent 6,435,406) discloses a remote ordering device.

Schena et al. (U.S. Patent Application Publication 2001/0001854) disclose printed medium activated interactive communication. Hudda et al. (U.S. Patent Application Publication 2001/0049636) disclose a system and method for wireless purchases of goods and services. Kargman (U.S. Patent Application Publication 2002/0049644) discloses a method for simplified one-touch ordering of goods and services from a wired or wireless phone or terminal). Tendler (U.S. Patent Application Publication 2002/0068549) discloses a location based service request system. Jones (U.S. Patent Application Publication 2002/0069312) discloses a system and method for the storage, management, and sharing of spatial-temporal based information. Avnet et al. (U.S. Patent Application Publication 2002/0094787) disclose a method and apparatus for transmitting information from point-to-point.

Taylor (UK Patent Application 2278196-A) discloses an information system using GPS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
NICHOLAS D. ROSEN  
PRIMARY EXAMINER

January 25, 2005